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PATENT
Customer No. 22,852
Attorney Docket No. 08049.0011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Oscar L. Avant et al.

Application No.: 09/652,707

Filed: August 31, 2000

For: APPARATUS AND METHODS
FOR PROCESSING MAILPIECE
INFORMATION BY AN
IDENTIFICATION CODE SERVER

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) Group Art Unit: 3653

)
) Examiner: Joseph C. Rodriguez

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) Confirmation No.: 3487

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO FOURTH RESTRICTION REQUIREMENT

Applicants file this paper in reply to the Office Action mailed December 29, 2004, the period for response to which has been extended through April 29, 2004, by a Petition for Three Month Extension of Time filed herewith.

In the Office Action, the Examiner required restriction among two groups of claims:

Group I - claims 21, 23-32, 34-45, 47-56, and 58-112, characterized by the Examiner as being drawn to at least three methods and corresponding devices for processing mail; and

Group II - claims 143, 145-157, and 159-172, characterized by the Examiner as being drawn to at least one method and corresponding device for processing mail.

Applicants respectfully traverse this restriction requirement because the Examiner has not alleged the burden necessary to require restriction after an action on the merits has issued.

The Office has already searched and examined all of the pending claims, as evidenced by the issuance of an Office Action on April 7, 2004. In that Office Action, the Examiner rejected all of the pending claims using the same reference, i.e., Handy et al., U.S. Patent No. 4,832,204. The Examiner further provided a Notice of References Cited listing references found during his search.

Restriction should usually be required before any action upon the merits. M.P.E.P. § 811 (8th ed. 2001, 2nd revision May 2004).¹ Moreover, “[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.” Id. The Office Action does not indicate whether the Examiner has made the required consideration, nor does it allege any “serious burden.” Further, Applicants submit that there can be no further burden because search and examination has already been undertaken for all of the pending claims.

Furthermore, Applicants submit that the office has had ample opportunity in the first three restriction requirements to limit the number of claims under examination. Thus, Applicants request the withdrawal of the pending restriction requirement.

¹ Indeed, in this application the Office previously required restriction (and Applicants complied) three times before proceeding on the merits.

However, to fully respond to the restriction requirement, Applicants provisionally elect to continue prosecution with the claims of Group I, i.e., claims 21, 23-32, 34-45, 47-56, and 58-112 if the requirement is maintained.

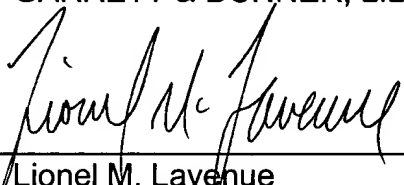
Please grant any additional extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 28, 2005

By: _____


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